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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,071	06/15/2001	Jason G. Jarman	SIGS-1-1001	1725

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,071

Applicant(s)

JARMAN ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's response of 1/9/06 has been entered. Currently claims 1-23,28-31 are pending. The examiner will address applicant's remarks at the end of this office action.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 19-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a "means for selling the personalized songs", which in the opinion of the examiner as this is best understood, includes people. Human beings are not allowed to be claimed as part of an invention in article claims. The specification discloses that musicians or artists are the ones that make the songs and sell the songs. The examiner also questions whether or not the "means for generating a request to an artist" can be a person. The examiner believes that it may include a person. The scope of claims 19-22 includes people, which renders the claims non-statutory.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8,19, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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For claim 8, the language “wherein *generating a song*” has no antecedent basis. The generating language has been deleted from claim 1 and is now written as modifying the song. Is the song being generated or is another song being modified? This is not clear.

For claim 19, the examiner is not clear as to what the scope of the term “means for selling the personalized songs” is supposed to be. What does this refer to? What structure is covered by this means plus function language? The examiner is not clear as to what structural aspect of the invention performs this function. Clarification and correction is required. Also not clear is what the “means for receiving the personalized song” is. What structure from the specification does this recite?

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by “Song Legacy Custom Songs”.

For claims 19,21,22, Song legacy discloses a system as claimed. Song legacy discloses that requests can be sent by email or by phone. This satisfies the claimed “means for receiving a request” for a personalized song. The

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“means for generating a request to an artist” is considered to be the employees of Song Legacy. Somebody has to inform the artist what to produce. The means for storing the personalized song are present in Song legacy because it is disclosed that songs are stored on disk. To store songs on disk you must have a means to store the song, such as hardware and software that allow the storage operation to occur. The database can be interpreted to be the CD’s with stored songs. The means for selling the songs can be the employees themselves or their website that advertises the business. The means for receiving the song is taken to be the manner in which the song is distributed to the requestor.

For claim 20, the employees of Song legacy are fully capable of making songs with the claimed genre. In the system claims recitations directed to the song itself receive minimal patentable weight because the songs are not part of the system.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

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Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-18,23,28-31, are rejected under 35 U.S.C. 103(a) as being unpatentable over "Song Legacy Custom Songs" in view of Clynes (5590282).

For claims 1,3-18,23, Song Legacy discloses a company that makes customized songs for a requestor. The requestor can request any kind of customized song they desire. The song can be for a birthday, anniversary, wedding, retirement, or any other function. The claimed providing a structure for a request is considered inherent because the "structure" for the request will inherently involve designating one of a genre, point of view, instrument choice, tempo, and recipient. A requestor requests a custom song, and Song legacy will then produce the custom song according to the request and product a CD recording of the song. The recording is then distributed to the recipient, who is the person receiving the recording.

Not disclosed by Song Legacy is that a song is retrieved and modified by altering the retrieved song to product the personalized song.

Clynes discloses a method of making personalized songs. Clynes discloses that 1st original songs are stored in a database. The 1st original songs have inherently been generated as claimed and are original. Clynes discloses that a person can specify and change various parameters of the original song to

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create a customized 2nd song. See column 5, where the many features that one can specify and customize about a song (includes tempo and musical instrument) to create a 2nd customized song are disclosed. Column 6, lines 1-6 disclose that the 2nd customized song can be saved in the database of the central computer 10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Song Legacy with the ability to take an original song and modify it to create the requested personalized song. One of ordinary skill in the art would recognize the desirability of this aspect. The examiner also views this limitation as being totally dependent on what the requestor wants. Song Legacy will make any song you request. That is the business they are in. With respect to modifying already made songs, it is well known and old in the art to take already produced songs and modify them to make a new version of the song. The examiner takes official notice of this fact. This happens all the time in advertising where older songs are redone by modifying them in some manner and using them in an advertising campaign. The examiner notes that Marilyn Monroe sang a customized version of "Happy Birthday" to the President of the United States. The song was modified by changing the tempo and some of the lyrics to address the recipient.

For claims 2,31, not disclosed is that the request is for a plurality of genres, tempos, etc.. The examiner interprets this to be the requesting of more than one song, because each song will have a different tempo or genre or even point of view. No two songs are the same and any two songs will satisfy what is claimed. It would have been obvious to one of ordinary skill in the art at the time

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the invention was made to receive a request for more than one song. Song legacy discloses that they can capture "the life story of the guest of honor on a personalized music CD". In view of this it would have been obvious to one of ordinary skill in the art that to capture the life story of the guest of honor, you would need more than one song. Claim 2 is just reciting the requesting of more than one song, which is obvious.

For claims 9-14,28-30, in addition to that above, Song legacy inherently has a request acquisition center (the telephone and area where the phone is located for the taking of song requests via the telephone), a recording development center (the recording studio), a reproduction center (the digital computer recording technology), an assignment center, and a distribution center (an area where finished recordings are located and ready to be delivered). Song legacy in view of Clynes performs all of the functions of receiving a song request, modifying an original song, recording the modified song on a storage medium, and distributing the song, so all of the structural "centers" claimed are found in Song legacy. For claim 11, the recording development center is fully capable of making more than one song as claimed. For claims 14,28 the songs are capable of being distributed over a network such as the postal service that mails packages. For claims 29,30, these claims do not recite any further structure to the system of claim 9, so the rejection satisfies what is claimed. Claims 29,30 are directed to the nature of the request and in article type of claims this defines no structure to the recited system.

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10. Applicant's arguments filed 1/9/06 have been fully considered but they are not persuasive.

The traversal for the 102 rejection is noted, but is found very confusing. Applicant has stated that the 102 rejection has been addressed by the reference to the Development Center that was present in figure 1 and in the specification. How can the specification address a rejection before the rejection was even known to applicant? What kind of argument is applicant attempting to make here? The examiner has no idea what applicant is attempting to argue. The examiner takes this portion of the response to be nothing more than a general allegation that the claims are novel because no specific and/or understandable reasoning has been provided. This traversal makes not sense at all.

With respect to applicant arguing that a CD cannot be considered a database, what claim is this argument for? Claim 1 has no database as a claimed element. Is this argument for claim 9? This is not clear. The 103 rejection of record uses a database as taught by Clynes where the songs are stored.

With respect to the traversal of the 102 rejection, the fact that Clynes discloses additional elements that applicant has not claimed does not render the rejection improper. Applicant uses "comprising" in the claims and this transitional phrase allows for additional elements to be present in a prior art reference. The statement that the claims do not have a subscribers post or a digital calculator so they are not anticipated by Clynes is non-persuasive.

The arguments are non-persuasive.

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER